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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/699,745 | 11/04/2003 | Timothy Richardson | 31655-2079 | 6408 |
| 33721 | 7590 | 02/06/2006 | EXAMINER | |
| MATTHEW MARGUAROT 79 WELLINGTON ST. WEST TORONTO, ON M5K 1N2 CANADA | | | FINEMAN, LEE A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2872 | |

DATE MAILED: 02/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/699,745 | Applicant(s) RICHARDSON, TIMOTHY | |
| | Examiner Lee Fineman | Art Unit 2872 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>11/4/03 & 6/18/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the recess having a sufficient amount of adhesive therein (claims 1-17) must be shown or the feature(s) canceled from the claim(s).

No new matter should be entered.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 52 (figs 16 and 17).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

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be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Independent claim 1 includes the limitation “a recess disposed in one of the slide base **and the cover slip**, the recess having a sufficient amount of adhesive therein...” Although the specification discloses on page 8, lines 19-29 a recess in the slide base, it fails to specifically identify a recess in the cover slip.

It is noted that the instant application claims priority as a continuation under 35 U.S.C 120. However, by correcting the lack of antecedent basis listed above, this application will include additional disclosure not presented in the prior application. Therefore it may constitute a continuation-in-part of the prior application rather than a continuation.

Claim Objections

4. Claims 9 and 10 are objected to because of the following informalities: The limitation “the active agent” lacks antecedent basis. Appropriate correction is required.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is

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appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-17 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3-7 and 9-11 of U.S. Patent No. 6,052,224. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are merely broader than or an obvious variation of the claims of U.S. Patent No. 6,052,224.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller, US 3,532,412.

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Regarding claims 1 and 2, Miller discloses in figs. 4 and 6 a slide system for microscopy comprising: a planar slide base (17); a planar cover slip (12); and a recess (19) disposed on the slide base (figs. 4 and 6), the recess having a sufficient amount of adhesive (13) therein to adhere the cover slip to the slide base when the cover slip is mounted on the slide base; and wherein the slide base and the cover slip each have a pre-selected thickness such that when the slide system is assembled it has a pre-selected thickness (figs. 4 and 6 and column 3, lines 61-67).

Regarding claims 3, Miller further discloses wherein the recess (19) is disposed on the slide base in the form of a continuous channel (fig. 4) which surrounds a sample area (18, in so far as the sample (S) is suspended and viewed in this area, therefore it is a sample area) on the slide base.

Regarding claim 4, Miller further discloses wherein the adhesive (13) continuously surrounds the sample area (fig. 4) such that when the cover slip is mounted to the slide base, the cover slip (12) and adhesive (13) define a sealed sample area (in conjunction with element 11) inhibiting migration of sample material out of the sealed sample area and inhibiting migration of contaminants into the sealed sample area (figs. 4 and 6).

9. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Binnings, US 3,620,596.

Regarding claims 1 and 2, Binnings discloses in figs. 1, 2 and 7 a slide system for microscopy comprising: a planar slide base (12); a planar cover slip (26); and a recess (18 and 22) disposed on the slide base (figs. 1, 2 and 7), the recess having a sufficient amount of adhesive (column 2, lines 70-73) therein to adhere the cover slip to the slide base when the cover

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slip is mounted on the slide base; and wherein the slide base and the cover slip each have a pre-selected thickness such that when the slide system is assembled it has a pre-selected thickness (figs. 2 and 7 and column 2, line 74-column 3, line 15).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-6, 11 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCormick, US 3,879,106 in view of Binnings.

Regarding claims 1-6 and 14-17, McCormick discloses in figs. 1 and 3 a slide system for microscopy comprising: a planar slide base (11); a planar cover slip (13); and a sufficient amount of adhesive (15a) therein to adhere the cover slip (13) to the slide base (11) when the cover slip is mounted on the slide base (fig. 3); wherein the slide base and the cover slip each have a pre-selected thickness such that when the slide system is assembled it has a pre-selected thickness (fig. 3 and column 3, line 68-column 4, line 5); wherein the adhesive (15a) continuously surrounds the sample area (between 21 and 11) such that when the cover slip is mounted to the slide base, the cover slip (13) and adhesive (15a) define a sealed sample area (fig. 3) inhibiting migration of sample material out of the sealed sample area and inhibiting migration of contaminants into the sealed sample area (column 3, lines 44-45); including an expansion volume (29) formed in the cover slip (13), the expansion volume surrounding the sample area

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(between 21 and 11). McCormick discloses the claimed invention except for a recess disposed in one of the slide base and the cover slip, the recess having a sufficient amount of adhesive therein; wherein the recess is disposed on the slide base in the form of a continuous channel which surrounds a sample area; and wherein the recess surrounds the expansion volume. Binnings teaches in figs. 1, 2 and 7 a slide system with a planar slide base (12); a planar cover slip (26); and a recess (18 and 22) disposed on the slide base (figs. 1, 2 and 7), the recess having a sufficient amount of adhesive (column 2, lines 70-73) therein to adhere the cover slip to the slide base when the cover slip is mounted on the slide base. It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a recess to the slide base of McCormick as suggested by Binnings to provide slides with better repeatability in accurately placing the sample for ease of locating the focal plane in a microscope (Binnings, column 1, lines 56-59). Therefore the recess is disposed on the slide base in the form of a continuous channel which surrounds a sample area (under the flange 23) and surrounds the expansion volume (29). The method of utilizing the structure of the claim is inherent therein.

Regarding claim 11, McCormick further discloses including at least one test material applied to at least one of the slide base and the cover slip (column 1, lines 40-48).

12. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCormick in view of Binnings as applied to claim 6 above and further in view of Self et al., WO 95/31529.

Regarding claims 7 and 9-10, McCormick in view of Binnings as applied to claim 6 above disclose the claimed invention except for including at least one active element, which is an antibiotic or an antiseptic, surrounding the expansion volume and being between the adhesive

and the expansion volume within the sealed sample area when the slide system is assembled. Self et al. teach a slide system (fig. 1) including at least one active element (with seal 16, see page 8, lines 22-25), which is an antibiotic or an antiseptic, surrounding the sample area. It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the active element of Self et al. to the system of McCormick in view of Binnings to be able to examine yet control live biological cultures (Self, page 8, lines 22-25).

Regarding claims 8, McCormick in view of Binnings and Self et al. as disclosed above, disclose the claimed invention except for including a second expansion volume. It would have been obvious to one having ordinary skill in the art at the time the invention was made to duplicate the expansion volume, since it has been held that a mere duplication of working parts of a device involves only routine skill in the art. One would have been motivated to duplicate the expansion volume for the purpose of better controlling the overflow of the sample. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960)

13. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCormick in view of Binnings as applied to claim 11 above and further in view of Pedroso et al., US 4,230,031.

McCormick in view of Binnings as applied to claim 11 above disclose the claimed invention except for explicitly stating that the test material comprises a stain that is biohazardous. Pedroso et al. teach the use a biohazardous stain when examining biological samples (column 1, lines 17-29). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the biohazardous stain propidium iodine suggested by

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Pedroso et al. as the test material in the system of McCormick in view of Binnings to be able to examine specific characteristics of biological samples.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (571) 272-2313. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LAF
February 3, 2006


MARK A. ROBINSON
PRIMARY EXAMINER